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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,234	11/06/2001	Barry S. Bosik	2001-0050	5492

7590 02/24/2005

Samuel H. Dworetsky  
AT&T CORP.  
P.O. Box 4110  
Middletown, NJ 07748-4110

EXAMINER

PHAN, JOSEPH T

ART UNIT PAPER NUMBER

2645

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/992,234

Applicant(s)

BOSIK ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/06/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/06/2001
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-16 rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al., Patent #6,233,318.**

Regarding claim 1, Picard teaches in a messaging system, a method of handling a voice mail message of a subscriber comprising the steps of: receiving an incoming call from a caller, prompting the caller to leave a message(*col.8 lines 32-41; understood that conventional manner prompts callers to leave a message*), recording the message on a voice mail server, sending a copy of the message to an email server(*col.9 lines 28-39 or col.13 lines 33-62*), notifying the subscriber of the message sent to the email server(*col.11 lines 28-42 and col.16 lines 5-8*), and updating status of the message in the voice mail server and the email server when the subscriber accesses one of the voice mail and email servers to retrieve the message(*col.2 lines 26-33 and col.7 lines 18-19; as currently recited, the voicemail and email server can be within the same system*).

Regarding claim 2, Picard teaches the method as recited in claim 1, further

Art Unit: 2645

comprising detecting on-line presence of the subscriber, and in response to said detecting, alerting an on-line subscriber of the presence of a new message (col.15 line 61-col.16 line 8).

Regarding claim 3, Picard teaches the method as recited in claim 1, wherein in said sending step, the copy of the message is an audio version of the message recorded on the voice mail server(col.9 lines 28-39 or col.13 lines 33-62).

Regarding claim 4, Picard teaches the method as recited in claim 1, wherein in said sending step, the copy of the message is a text version of the message recorded on the voice mail server(col.8 lines 55-58).

Regarding claim 5, Picard teaches the method as recited in claim 1, wherein said notifying step includes providing a visual indication on a display(col.6 lines 59-62).

Regarding claim 6, Picard teaches the method as recited in claim 1, wherein said notifying step includes providing an audio indication through a PC(col.6 lines 35-55).

Regarding claim 7, Picard teaches the method as recited in claim 1, wherein said notifying step includes transmitting notification of the new message via Internet(col.15 line 61-col.16 line 8).

Regarding claim 8, Picard teaches in a message management system, a method of handling an email for a subscriber comprising the steps of: receiving an email message through an email server, sending a copy of the message to a voice mail server, converting the message to an audio format, saving the converted message on the voice mail server(col.12 lines 11-43 and col.13 lines 11-21),

Art Unit: 2645

and updating a status indicator for the message in the email server and the voice mail server when the subscriber accesses one of the email or voice mail servers to retrieve the message(col.15 line 61-col.16 line 8; *as currently recited, the voicemail and email server can be within the same system*).

Regarding claim 9, Picard teaches the method as recited in claim 8, wherein said converting step includes performing text-to-speech conversion(col.7 line 65-col.8 line 29).

Regarding claim 10, Picard teaches in an integrated message management system for processing messages including: a voice mail server that records and stores voice mail messages, sends copies of voice mail messages to an email server(col.9 lines 28-39 or col.13 lines 33-62), and includes a status indicator for each of the voice mail messages, an email server that stores voice mail messages as email, sends notice of new messages to a subscriber, and includes a status indicator generator for generating an indication for each of the voice mail messages stored as email messages(col.11 lines 28-42 and col.16 lines 5-8), and a message manager(Fig.4) that links together the voice mail server and email server, controls all interaction between the voice mail server and email server(col.15 line 61-col.16 line 8), updates the status indicator generator of a voice mail message on the voice mail server when the subscriber accesses the voice mail message as email on the email server, and updates the retrieval status indicator of the voice mail message as email on the email server when the subscriber accesses the voice mail message on the voice mail server(col.2 lines 26-33 and col.7 lines 18-19; *as currently recited, the*

*voicemail and email server can be within the same system).*

Regarding claim 11, Picard teaches the system as recited in claim 10, further including a presence server that provides indication as to whether the subscriber is connected to the Internet, and wherein the email server only sends notice to the subscriber if the presence server indicates that the subscriber is connected to the Internet(col.15 line 61-col.16 line 8).

Regarding claim 12, Picard teaches the system as recited in claim 10, wherein the email server also stores conventional email messages, sends copies of the email messages to the voice mail server, includes a status indicator for each of the email messages, wherein the voice mail server converts the email messages to voice mail messages using a text-to-speech conversion module, stores the converted messages, and includes a status indicator for each converted message(col.7 line 65-col.8 line 29), and wherein the message manager updates the status indicator of a converted message on the voice mail server when the subscriber accesses the email message on the email server, and updates the retrieval status indicator of the email message on the email server when the subscriber accesses the converted message on the voice mail server(col.2 lines 26-33 and col.7 lines 18-19; *as currently recited, the voicemail and email server can be within the same system).*

Regarding claim 13, Picard teaches the system as recited in claim 12, further including a presence server that provides indication as to whether the subscriber is connected to the Internet, and wherein the email server only sends notice to the subscriber if the presence server indicates that the subscriber is connected to the

Art Unit: 2645

Internet(col.15 line 61-col.16 line 8).

Regarding claim 14, Picard teaches the system as recited in claim 10, wherein the email server further includes a "voice mail stored as email" storage facility that stores said voice mail as email, and wherein the voice mail server further includes a voice mail box that stores said voice mail messages(Fig.4, *col.2 lines 26-33, col.7 lines 18-19, col.9 lines 28-39 or col.13 lines 33-62*).

Regarding claim 15, Picard teaches the system as recited in claim 11, wherein the email server further includes a "voice mail stored as email" storage facility that stores said voice mail as email, and wherein the voice mail server further includes a voice mail box that stores said voice mail messages(Fig.4, *col.2 lines 26-33, col.7 lines 18-19, col.9 lines 28-39 or col.13 lines 33-62*).

Regarding claim 16, Picard teaches the system as recited in claim 12, wherein the email server further includes an email storage facility that stores said conventional email messages and a "voice mail stored as email" storage facility that stores said voice mail as email, and wherein the voice mail server includes a voice mail storage facility that stores said voice mail messages and an "email stored as voice mail" storage facility that stores said converted messages(Fig.4, *col.2 lines 26-33, col.7 lines 18-19, col.9 lines 28-39 or col.13 lines 33-62*).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-

Art Unit: 2645

3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP  
February 22, 2005



OVIDIO ESCALANTE  
PATENT EXAMINER

